

REMARKS

The claims have been amended to address the objections raised in cipher 2 of the Action, and also to better define the claimed invention, and better distinguish the claimed invention from the prior art. Each of the independent claims has been amended to clarify that the claimed apparatus is capable of holding a fish by a lip, and that the apparatus includes a protrusion extending from the spacer for preventing a fish from being inserted too far into a clip.

All of the claims have been rejected as obvious from Johnson (U.S. Patent No. 6,044,582) in view of Applicant's admitted prior art (APA). In so rejecting the claims, the Examiner acknowledges Johnson's clip is quite different from the claimed invention, but takes the position that it would be obvious to use the clip of the APA in place of the clip disclosed by Johnson. The Examiner's rejection is based on hindsight. Clearly, the instant inventor, who is most familiar with the APA¹, until he made the present invention never considered the APA clip could be modified by the addition of a rope, and advantageously used for holding a fish by a lip as required by the instant claims. At best, the APA is what the courts refer to as an "accidental" anticipation. It is well settled law dating from the 1880 Supreme Court case of Tilghman v. Proctor, 102 US 707 (Sup. Ct. 1880) that an accidental, unintended and unappreciated achievement of a product or process does not constitute anticipation under the Patent Law. The proposition of Tilghman was confirmed by the Supreme Court in a 1923 decision in Eibel Process Company v. Minnesota & Ontario Paper Company, 261 US 45 (Sup. Ct. 1923), and in numerous Trial and Appeals Courts. Recent Federal Court decisions emphasize that an anticipatory inherent feature or result must be (1) consistent, (2) necessary and (3) inevitable, not

¹ The APA was invented by the instant Applicant, and sold by Applicant's company for many years.

merely possible or probable. See, also, Glaxo, Inc. v. Novopharm, Ltd., 52 F.3d 1043 (Fed. Cir. 1995) Cert. denied, 516 US 998 (1995). Here, the APA could not even be used as a fish clip, without modification by the addition of a rope.

Moreover, it would be counterintuitive to secure a rope to the APA clip. As described in Applicant's specification, the APA clip is designed to be secured to a garment hanger. Attaching a length of rope to the APA hanger would interfere with its intended use, i.e., as a close hanger.

It also is submitted there is nothing contained within the four corners of Johnson or the APA which would motivate one skilled in the fishing device art to look to the home closet for clothes hanging clips or vice versa. Needless to say, a fishing hole and a clothes closet are a long way from one another.

In establishing a *prima facie* case of obviousness under 35 USC §103, it is incumbent upon the Examiner to provide a "clear and particular" showing of "actual evidence" of a suggestion, teaching, or motivation to combine references. In re Dembiczak, 50 USPQ 2d, 1614, 1617 (Fed. Cir. 1999). "Broad conclusory statements regarding the teachings of multiple references, standing alone, are not evidence." Id., citing McElmury v. Arkansas Power and Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) (internal quotations omitted).

In In re Dembiczak, the Court of Appeals for the Federal Circuit recognized that "rigorous application" of the requirement for a showing of a teaching or motivation to combine references is the "best defense against the subtle but powerful attraction" of improper hindsight-based obvious analysis. Id.; see also, Para-Ordnance Manufacturing, Inc. v. SGS Importers International, Inc., 73 F.3d 1085, 37 USPQ2d 1237 (Fed. Cir. 1995) ("obviousness may not be

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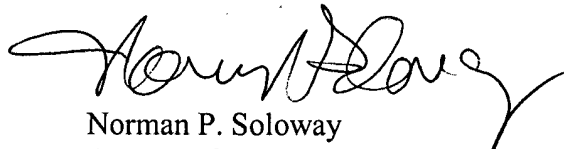
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established using hindsight or in view of the teachings or suggestions of the inventor"). This is especially true in cases where the ease with which the invention may be understood "may prompt one to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher." Id. citing W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). That is exactly the situation here, where the Applicant's own art is being used against him!

In view of the foregoing amendments and comments, it is submitted that the Application now is in order for allowance.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account Number 08-1391.


Respectfully submitted,



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